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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,019	11/24/2003	Jeffrey C. Felt	32355.12.1.3.2	6543

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EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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08/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,019

Applicant(s)

FELT ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31 and 34-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31 and 34-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/11/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31, 38, 45, 47-49, 51-54, are rejected under 35 U.S.C. 102(e) as being anticipated by Fell et al. (6,206,927).

With respect to the above claims, Fell et al disclose a system for the modification of the knee, the system comprising a knee implant, as best seen in FIG.4, that provides a first major surface (FIG.6) adapted to be positioned upon a tibial plateau, and a second major surface adapted to be positioned against a femoral condyle as best seen in FIG.5, the second major surface being provided with a femoral glide path as best seen in FIGS. 5, 6, and as set forth in column 6, lines 60-67, to facilitate its performance in situ, the glide path being in the form of a generally central depression; as best seen in FIGS.5, 6, the implant further comprising one or more tibial projections (28,29) as seen in FIGS. 10,11, as set forth in column 12, lines 1-39, the projections extending distally over a rim of the tibia plateau and into a posterior cruciate ligament fossa of a tibia, wherein the implant remains substantially permanently anchored in place with respect to the tibia plateau when positioned in the knee by a combination comprising the first major surface, the second major surface, and the tibial projections; as set forth in

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column 12, lines 1-67; column 14, lines 1-30. The implant includes a posterior lip (29).

The second surface has a concave shape, as best seen in FIGS 5,6. The implant can be made from a metal or polymer, as set forth in column 4, lines 20-34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-37,39-44, 46,55,56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Link (5,944,759).

Link teaches the claimed invention, except for the ranges as set forth in claims 34-37,39-44, as claimed by applicant. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the implant of Link having different ranges as claimed by applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With respect to claims 45,55,56, this particular shape or configuration is nothing more than one of numerous configurations or shapes one of ordinary skill in the art would find obvious for the purpose of providing a mating surface in the tibia plateau. In re Dailey, 149 USPQ 47 (CCPA 1976).

Response to Amendment

Applicant's arguments filed 6/11/07 have been fully considered but they are not persuasive. In the course of the interview conducted on 5/30/07, applicant agreed to amend at least claim 31 to overcome the rejection over Felt et al. However, in the formal amendment submitted herein, applicant only changed "the tibial projection(s) being adapted to extend" to —extending—, and also added —with respect to the tibial plateau—. These amendments fails to overcome the rejections over felt et al. For example, Felt et al, in column 14, lines 15-30, teach the projections or cusps extend over a rim of the tibial plateau. Felt et al disclose in column 14, lines 21-24 "During the testing and at the end of each test, the device was noted to be in its original position relative to the tibial plateau throughout normal and extra-normal flexing of the knee". This suggests that the device is permanently anchored in place. Also in column 7, lines 27-29, Felt et al disclose that "in addition, the posterior rim and the large radius of the tibial side of the device prevents the device from "spitting"". Again Felt et al disclose the invention, as claimed by applicant.

Although in the interview, applicant stated that he would amend the claims, as discussed, to overcome Felt et al, the claims, as herein presented, fail to overcome the rejection. The rejection is made final.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
August 18, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER